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REMARKS

In the Office Action, the Examiner rejected claims 1-7, 9-11, 16-29, 34-36, and 42-47 under 35 U.S.C. § 103(a) as unpatentable over Fortman et al. (U.S. Patent No. 5,987,100) in view of Rodriguez et al. (US Patent Publication No. 2002/0067806); rejected claims 12, 13, 30, and 31 under 35 U.S.C. § 103(a) as unpatentable over Fortman et al. in view of Rodriguez et al. and McAllister et al. (U.S. Patent No. 6,442,242); rejected claims 14, 15, 32, and 33 under 35 U.S.C. § 103(a) as unpatentable over Fortman et al. in view of Rodriguez et al. and Tullis et al. (U.S. Patent No. 5,802,314); rejected claims 37-40, 48, and 49 under 35 U.S.C. § 103(a) as unpatentable over Fortman et al. in view of Tullis et al.; and rejected claim 41 under 35 U.S.C. § 103(a) as unpatentable over Fortman et al. in view of Tullis et al. and Rodriguez et al.

By this Amendment, Applicants amend claims 1-3, 10, 18-20, 22, 23, 28, 36, 37, 42, 45, and 49 to improve form. Applicants respectfully traverse the Examiner's rejections under 35 U.S.C. § 103 with regard to the amended claims. Claims 1-7 and 9-49 are pending.

In paragraph 3 of the Office Action, the Examiner rejected claims 1-7, 9-11, 16-29, 34-36, and 42-47 under 35 U.S.C. § 103(a) as allegedly unpatentable over Fortman et al. in view of Rodriguez et al. Applicants traverse the rejection with regard to the amended claims.

Amended claim 1, for example, recites a combination of features of a method for delivering a message to a receiving party. The method comprises receiving a message intended for the receiving party; determining whether the message should be delivered to the receiving party; translating the message from a source format to message text; converting the message text to an audible message when the message should be delivered to the receiving party; determining a date or time at which the audible message should be delivered; initiating a telephony call to the

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receiving party at the determined date or time; and delivering the audible message to the receiving party during the telephony call.

Neither Fortman et al. nor Rodriguez et al., whether taken alone or in any reasonable combination, discloses or suggests the combination of features recited in amended claim 1. For example, neither Fortman et al. nor Rodriguez et al. discloses or suggests determining a date or time at which an audible message should be delivered. Instead, Fortman et al. discloses sending a notification when a message is received (col. 6, line 66 - col. 7, line 13) and sending the message when the subscriber establishes a connection to request retrieval of the message (col. 7, lines 32-36). Rodriguez et al. discloses sending an urgent message to a subscriber when the message is received (Abstract).

Because neither Fortman et al. nor Rodriguez et al. discloses or suggests determining a date or time at which the audible message should be delivered, Fortman et al. and Rodriguez et al. cannot disclose or suggest initiating a telephony call to a receiving party at the determined date or time, as further required by claim 1. The Examiner alleged that Fortman et al. discloses initiating a telephony call and cited column 5, lines 10-15 and 42-49, of Fortman et al. for support (Office Action, page 3).

Column 5, lines 10-15, of Fortman et al. corresponds to Table 1 in Fortman et al. In Table 1, Fortman et al. discloses different types of notifications. Nowhere in this table, or elsewhere, does Fortman et al. disclose or suggest initiating a telephony call at a determined date or time, as required by claim 1.

At column 5, lines 42-49, Fortman et al. discloses:

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Subscriber mailbox 3300 preferably also stores a database of subscriber profile data. The subscriber profile data includes subscriber-defined information regarding the subscriber's notification preferences. The subscriber profile data might include any of the notification types shown in Table 1, including notifying the subscriber using a message waiting light or tone, or by sending part or all of the message to the subscriber as the notification.

Nowhere in this section, or elsewhere, does Fortman et al. disclose or suggest initiating a telephony call to a receiving party at a determined date or time, as required by claim 1.

For at least these reasons, Applicants submit that claim 1 is patentable over Fortman et al. and Rodriguez et al., whether taken alone or in any reasonable combination. Claims 2-7, 9-11, and 16-18 depend from claim 1 and are, therefore, patentable over Fortman et al. and Rodriguez et al. for at least the reasons given with regard to claim 1.

Amended independent claim 19 recites a combination of features of a system for presenting a message to a receiving party. The system comprises means for obtaining a user profile corresponding to the receiving party, where the user profile comprises delivery data that specifies a time or date of message delivery. The system also comprises means for obtaining a message intended for the receiving party, means for testing the message against the user profile, means for converting the message to an audible message when the message passes the test, means for initiating a telephony call to the receiving party based on the delivery data, and means for presenting the audible message to the receiving party during the telephony call.

Neither Fortman et al. nor Rodriguez et al., whether taken alone or in any reasonable combination, discloses or suggests the combination of features recited in claim 19. For example, neither Fortman et al. nor Rodriguez et al. discloses or suggests means for obtaining a user profile corresponding to the receiving party, where the user profile comprises delivery data that specifies a time or date of message delivery.

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Because Fortman et al. and Rodriguez et al. do not disclose or suggest a user profile that comprises delivery data that specifies a time or date of message delivery, Fortman et al. and Rodriguez et al. cannot disclose or suggest means for initiating a telephony call to a receiving party based on the delivery data, as further recited in claim 19.

For at least these reasons, Applicants submit that claim 19 is patentable over Fortman et al. and Rodriguez et al., whether taken alone or in any reasonable combination.

Independent claim 20 recites a combination of features of a message delivery system. The system comprises a message receiver and a call processor. The message receiver is configured to obtain a message intended for a receiving party, determine whether the message should be delivered to the receiving party, and convert the message from a source format to a target format when the message should be delivered to the receiving party. The call processor is configured to convert the message from the target format to an audible format, initiate a telephony call to the receiving party at a time specified by the receiving party, and deliver the message in the audible format to the receiving party during the telephony call.

Neither Fortman et al. nor Rodriguez et al., whether taken alone or in any reasonable combination, discloses or suggests the combination of features recited in claim 20. For example, neither Fortman et al. nor Rodriguez et al. discloses or suggests a call processor that is configured to initiate a telephony call to the receiving party at a time specified by the receiving party. Instead, Fortman et al. discloses sending a notification when a message is received (col. 6, line 66 - col. 7, line 13) and sending the message when the subscriber establishes a connection to request retrieval of the message (col. 7, lines 32-36); and Rodriguez et al. discloses sending an urgent message to a subscriber when the message is received (Abstract).

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For at least these reasons, Applicants submit that claim 20 is patentable over Fortman et al. and Rodriguez et al., whether taken alone or in any reasonable combination. Claims 21-29 and 34-36 depend from claim 20 and are, therefore, patentable over Fortman et al. and Rodriguez et al. for at least the reasons given with regard to claim 20.

Amended claim 42 recites a combination of features of a method for providing enhanced message services. The method comprises interacting with a user to generate a user profile that identifies at least one message criterion that indicates when messages should be delivered to the user; monitoring a message server for arrival of new messages intended for the user; processing the new messages, including determining whether the new messages should be delivered to the user based on the user profile, translating the new messages from a source format to a text format, and converting the new messages from the text format to an audible format, as audible messages, when the new messages should be delivered to the user; and delivering the audible messages to the user based on the at least one criterion, including initiating a telephony call to the user, and presenting the audible messages to the user during the telephony call.

Neither Fortman et al. nor Rodriguez et al., whether taken alone or in any reasonable combination, discloses or suggests the combination of features recited in claim 42. For example, neither Fortman et al. nor Rodriguez et al. discloses or suggests interacting with a user to generate a user profile that identifies at least one message criterion that indicates when messages should be delivered to the user and delivering the audible messages to the user based on the at least one criterion.

The Examiner alleged that Fortman et al. discloses interacting with a user to generate a user profile that identifies at least one message criterion that indicates when messages should be

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delivered to the user and cited column 5, lines 10-15 and 42-49, and column 7, lines 17, 18, and 49-64, of Fortman et al. for support (Office Action, page 8). Applicants respectfully disagree.

Column 5, lines 10-15, of Fortman et al. corresponds to Table 1 in Fortman et al. In Table 1, Fortman et al. discloses different types of notifications that may be used to notify a subscriber of a pending message. Fortman et al. does not disclose or suggest at least one message criterion that indicates when messages should be delivered to the user, as required by claim 42.

At column 5, lines 42-49, Fortman et al. discloses:

Subscriber mailbox 3300 preferably also stores a database of subscriber profile data. The subscriber profile data includes subscriber-defined information regarding the subscriber's notification preferences. The subscriber profile data might include any of the notification types shown in Table 1, including notifying the subscriber using a message waiting light or tone, or by sending part or all of the message to the subscriber as the notification.

Nowhere in this section, or elsewhere, does Fortman et al. disclose or suggest at least one message criterion that indicates when messages should be delivered to the user, as required by claim 42.

At column 7, lines 16-19, Fortman et al. discloses that the "subscriber notification may include a message waiting light or tone on the subscriber's telephone, or the message itself delivered to the subscriber's ADSI telephone, pager, fax, or computer (Table 1)." Nowhere in this section, or elsewhere, does Fortman et al. disclose or suggest at least one message criterion that indicates when messages should be delivered to the user, as required by claim 42.

At column 7, lines 49-64, Fortman et al. discloses:

For example, if the subscriber uses ADSI telephone 2130 to retrieve the pending message, the subscriber must specify whether the pending message should be downloaded in voice or ADSI text form.

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Interface 3100 then routes the request to service provider 3200. Based on the detected type of subscriber telecommunications equipment and any subscriber specified retrieval format, service provider 3200 determines the subscriber's retrieval format [step 8300]. Service provider 3200 reads the pending message from subscriber mailbox 3300 and determines whether the message is already in the retrieval format [step 8400]. The message would already be in the retrieval format if the retrieval format is the same as the caller format or the subscriber's normal retrieval format. If the message is already in the retrieval format, then service provider 3200 sends the message to the subscriber [step 8500].

Nowhere in this section, or elsewhere, does Fortman et al. disclose or suggest at least one message criterion that indicates when messages should be delivered to the user, as required by claim 42.

For at least these reasons, Applicants submit that claim 42 is patentable over Fortman et al. and Rodriguez et al., whether taken alone or in any reasonable combination. Claims 43-47 depend from claim 42 and are, therefore, patentable over Fortman et al. and Rodriguez et al. for at least the reasons given with regard to claim 42.

In paragraph 4 of the Office Action, the Examiner rejected claims 12, 13, 30, and 31 under 35 U.S.C. § 103(a) as allegedly unpatentable over Fortman et al. in view of Rodriguez et al. and McAllister et al. Applicants respectfully traverse the rejection.

The McAllister et al. patent cannot be used as prior art against this application under 35 U.S.C. § 103. Effective November 29, 1999, subject matter that was prior art under 35 U.S.C. § 103 via 35 U.S.C. § 102(e) is disqualified as prior art against the claimed invention if that subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person (35 U.S.C. § 103(c)). The subject matter of the McAllister et al. patent and the claimed invention of the present application were, at the time the invention was made, owned by the same person or subject to an obligation

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of assignment to the same person, namely Verizon. Therefore, the McAllister et al. patent cannot be used as prior art against this application under 35 U.S.C. § 103.

Applicants noted this deficiency in the Examiner's rejection in the Amendment, filed July 11, 2003, and again in the Request for Reconsideration, filed December 23, 2003. The Examiner maintained the rejection without addressing Applicants' arguments. Because the McAllister et al. patent is not prior art against this application, any rejection based on the McAllister et al. patent must be withdrawn.

For at least the foregoing reasons and the reasons given above with regard to claims 1 and 20 (from which claims 12, 13, 30, and 31 depend), Applicants submit that claims 12, 13, 30, and 31 are patentable over Fortman et al. and Rodriguez et al., whether taken alone or in any reasonable combination.

In paragraph 5 of the Office Action, the Examiner rejected claims 14, 15, 32, and 33 under 35 U.S.C. § 103(a) as allegedly unpatentable over Fortman et al. in view of Rodriguez et al. and Tullis et al. Applicants respectfully traverse the rejection.

Claims 14 and 15 depend from claim 1. The disclosure of Tullis et al. does not cure the deficiencies in the disclosures of Fortman et al. and Rodriguez et al. identified above with regard to claim 1. Therefore, claims 14 and 15 are patentable over Fortman et al., Rodriguez et al., and Tullis et al. for at least the reasons given with regard to claim 1. Claims 14 and 15 are also patentable for reasons of their own.

Claims 14 and 15 recite determining whether one or more message attachments are convertible into text, generating a description of the one or more message attachments when the one or more message attachments are not convertible into text (claim 14), and translating the

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message text and the generated description into an audible message (claim 15). Neither Fortman et al., Rodriguez et al., nor Tullis et al. discloses or suggests these features.

The Examiner admitted that Fortman et al. and Rodriguez et al. do not disclose the first two features, but alleged that Fortman et al. discloses the third feature (Office Action, pages 9 and 10). The Examiner further alleged that Tullis et al. discloses the first and second features (Office Action, pages 9 and 10). Applicants submit that the Examiner's reasoning is flawed. If Fortman et al. and Rodriguez et al. do not disclose determining whether one or more message attachments are convertible into text or generating a description of the one or more attachments when the one or more attachments are not convertible into text, then Fortman et al. and Rodriguez et al. CANNOT disclose or suggest translating the text message and the generated description into an audible message. Therefore, contrary to the Examiner's allegation, neither Fortman et al., Rodriguez et al., nor Tullis et al., whether taken alone or in any reasonable combination, discloses or suggests generating a description of one or more message attachments and translating the generated description into an audible message, as recited in claims 14 and 15.

For at least these reasons, Applicants submit that claims 14 and 15 are patentable over Fortman et al., Rodriguez et al., and Tullis et al., whether taken alone or in any reasonable combination.

Claims 32 and 33 depend from claim 20. The disclosure of Tullis et al. does not cure the deficiencies in the disclosures of Fortman et al. and Rodriguez et al. identified above with regard to claim 20. Therefore, claims 32 and 33 are patentable over Fortman et al., Rodriguez et al., and Tullis et al. for at least the reasons given with regard to claim 20. Claims 32 and 33 also recite features similar to features described above with regard to claims 14 and 15. Claims 32 and 33

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are, therefore, also patentable over Fortman et al., Rodriguez et al., and Tullis et al. for reasons similar to reasons given with regard to claims 14 and 15.

In paragraph 6 of the Office Action, the Examiner rejected claims 37-40, 48, and 49 under 35 U.S.C. § 103(a) as allegedly unpatentable over Fortman et al. in view of Tullis et al.

Applicants respectfully traverse the rejection.

Amended independent claim 37 recites a combination of a computer-readable medium that stores instructions executable by at least one computer to perform a method for presenting a message to a receiving party. The computer-readable medium comprises instructions for obtaining a message intended for the receiving party, where the message includes one or more message attachments; instructions for determining whether the one or more message attachments are convertible into a target format; instructions for generating a description of the one or more message attachments when the one or more message attachments are not convertible into the target format; instructions for initiating a voice call to the receiving party; and instructions for presenting the message with the generated description to the receiving party during the voice call.

Neither Fortman et al. nor Tullis et al., whether taken alone or in any reasonable combination, discloses or suggests the combination of features recited in claim 37. For example, neither Fortman et al. nor Tullis et al. discloses or suggests instructions for initiating a voice call to the receiving party and instructions for presenting the message with the generated description to the receiving party during the voice call.

The Examiner alleged that Fortman et al. discloses these features and cited column 5, lines 10-15 and 42-49, and column 7, lines 17 and 18, of Fortman et al. for support (Office Action, page 13). Applicants respectfully disagree.

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These sections of Fortman et al. have been reproduced above. Fortman et al. discloses that a subscriber is notified of a pending message and that this notification can include sending part or all of the message to the subscriber (col. 5, lines 10-30 and 42-49). Fortman et al. clarifies, however, that sending the message as the notification is performed only when the subscriber uses an ADSI telephone, a pager, a fax machine, or a computer (Table 1; col. 7, lines 16-19). Notifications in any of these situations would not include a voice call, as shown in Table 1 of Fortman et al.

For at least these reasons, Applicants submit that claim 37 is patentable over Fortman et al. and Tullis et al., whether taken alone or in any reasonable combination. Claims 38-40 depend from claim 37 and are, therefore, patentable over Fortman et al. and Tullis et al. for at least the reasons given with regard to claim 37.

Independent claim 48 recites a combination of features of an automated method for delivering a message to a receiving party. The method comprises receiving a message intended for the receiving party, where the message includes a message portion and one or more attachments in a source format; determining whether the one or more attachments can be converted to a target format; generating a description of the one or more attachments when the one or more attachments cannot be converted to the target format; converting the message portion to an audible message; initiating a telephony call to a telephony device associated with the receiving party; and delivering the audible message and the generated description to the receiving party during the telephony call.

Neither Fortman et al. nor Tullis et al., whether taken alone or in any reasonable combination, discloses or suggests the combination of features recited in claim 48. For example,

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neither Fortman et al. nor Tullis et al. discloses or suggests initiating a telephony call to a telephony device associated with the receiving party and delivering the audible message and the generated description to the receiving party during the telephony call.

The Examiner rejected claim 48 by referring generally to the rejection of claim 37 (Office Action, page 13). With regard to claim 37, the Examiner alleged that Fortman et al. discloses similar features and cited column 5, lines 10-15 and 42-49, and column 7, lines 17 and 18, of Fortman et al. for support (Office Action, page 13). Applicants respectfully disagree.

These sections of Fortman et al. have been reproduced above. Fortman et al. discloses that a subscriber is notified of a pending message and that this notification can include sending part or all of the message to the subscriber (col. 5, lines 10-30 and 42-49). Fortman et al. clarifies, however, that sending the message as the notification is performed only when the subscriber uses an ADSI telephone, a pager, a fax machine, or a computer (Table 1; col. 7, lines 16-19). Fortman et al. does not disclose or suggest sending an audible message and a generated description as the notification to a telephony device of the subscriber, as required by claim 48.

For at least these reasons, Applicants submit that claim 48 is patentable over Fortman et al. and Tullis et al., whether taken alone or in any reasonable combination. Claim 49 depends from claim 48 and is, therefore, patentable over Fortman et al. and Tullis et al. for at least the reasons given with regard to claim 48.

In paragraph 7 of the Office Action, the Examiner rejected claim 41 under 35 U.S.C. § 103(a) as allegedly unpatentable over Fortman et al. in view of Tullis et al. and Rodriguez et al. Applicants respectfully traverse the rejection.

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Claim 41 depends from claim 37 and is patentable over Fortman et al., Tullis et al., and Rodriguez et al. for at least the reasons given with regard to claim 37.

Further, Applicants submit that the Examiner's rejection of claim 41 is improper. The Examiner rejected claim 41 based on a combination of Fortman et al., Tullis et al., and Rodriguez et al., but did not rely on any portion the Tullis et al. reference in the rejection (Office Action, page 14). Also, the Examiner provided no motivation for combining the alleged teachings of Fortman et al., Tullis et al., and Rodriguez et al. Therefore, the Examiner did not establish a prima facie case of obviousness under 35 U.S.C. § 103 with regard to claim 41.

For at least these reasons, Applicants submit that claim 41 is patentable over Fortman et al., Tullis et al., and Rodriguez et al., whether taken alone or in any reasonable combination.

In view of the foregoing amendments and remarks, Applicants respectfully request the reconsideration of this application and the allowance of the pending claims.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 07-2339 and please credit any excess fees to such deposit account.

Respectfully submitted,
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